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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

200207081-1 (50833-1510)

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Typed or printed name _____

Application Number

10/631,160

Filed

July 31, 2003

First Named Inventor

James R. Peterson

Art Unit

2181

Examiner

Patel, Niketa I.

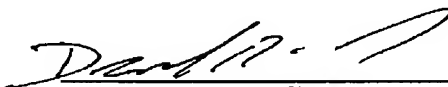
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☐ attorney or agent of record.
Registration number _____☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 38,962

Signature

Daniel R. McClure

Typed or printed name

770-933-9500

Telephone number

January 2, 2007

Date

NOTE: Signatures of all the Inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)
)
 Peterson, et al) Group Art Unit: 2181
) Examiner: Patel, Niketa I.
 Serial No.: 10/631,160)
) Confirmation No. 7545
 Filed: July 31, 2003)
) TKHR Dkt. No. 50833-1510
) HP Docket No. 200207081-1
 For: System and Method for Adaptive Buffer)
 in a Memory Device Interface)

REMARKS IN SUPPORT OF APPLICANTS'
PRE-APPEAL BRIEF CONFERENCE REQUEST

Mail Stop: Appeal
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submit the following remarks in support of a Request for Pre-Appeal
Brief Conference.

AUTHORIZATION TO DEBIT ACCOUNT

It is believed that no extensions of time or fees for net addition of claims are required, beyond those, which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account No. 08-2025.

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REMARKS

Simply stated, the Examiner prematurely made FINAL the Office Action mailed November 2, 2006, as the Applicants have not yet been given a fair opportunity to develop clear issues for a proper appeal. In this regard, MPEP 706.07 clearly and unequivocally states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; ...

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. ...

By making the Office Action of November 2, 2006, FINAL, the Examiner has failed to comply with this clear MPEP directive.

In this regard, there are 5 independent claims in this application: claims 1, 6, 10, 15, and 19. Despite the fact that these claims each define unique and different subject matter, the Office Action (mailed May 15, 2006), which immediately preceded the present FINAL Office Action, rejected these claims as a group, stating:

Referring to claims 1, 6, 10, 15, 19, Boyle teaches a method and a memory device interface comprising: determining at least one characteristic [see column 3, lines 45-48 and column 7, lines 8-19] of a first input/output (I/O) device [see figure 2, element 22] that is coupled to a memory device interface [see figure 2, element 80], the memory device interface being configured to enable data transfers between the I/O device and a memory device [see column 7, lines 37-43 'transfers'] and buffering data corresponding to the first I/O device in a first portion of a buffer of the memory device interface [see figure 2, element 41], a size of the first portion being responsive to the at least one characteristic of the first I/O device [see column 7, lines 5-19, 37-43, 59-62]; determining at least one characteristic [see column 3, lines 54-62 and column 7, lines 8-19] of a

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second I/O device [see figure 2, element 24] that is coupled to the memory device interface [see figure 2, element 80]; and buffering data corresponding to the second I/O device in a second portion of the buffer [see figure 2, element 42], a size of the second portion being responsive to the at least one characteristic of the second I/O device [see column 7, lines 5-19, 37-43, 59-62].

The substantive language quoted above, however, tracks only the language of claim 1 of the present application, does not address or mention unique elements of the other rejected claims. As such, Applicants substantively responded to this rejection, in connection with the arguments presented in support of the patentability of claim 1. As to the unique element of claim 6, 10, 15, and 19, which were not addressed in this rejection, however, Applicants were unable to adequately or fairly respond to the rejections. Indeed, in Applicants' prior response, Applicants pointed out to the Examiner that the language of independent claims 6, 10, 15, and 19 each differ from the language of claim 1 (the only language addressed in the rejection), and requested that these claims be treated individually (as they should have been in the previous Office Action).

In the present (FINAL) Office Action, the Examiner has, in fact, addressed each of these remaining independent claims on an individual basis. Indeed, the language now quoted for each of these claims parallels the language of each claim. However, Applicant has not yet had a fair opportunity to properly develop the issues for appeal in these claims, as these new rejections have been made FINAL.

Consider the last element of claim 6 as an example. With respect to this last element, the FINAL Office Action states:

wherein the buffering capacity of the first portion is responsive to at least one characteristic of a first I/O device that provides data to the memory device interface via the first data transfer link **[see column 7, lines 5-19, 37-43, 59-62 and column 4, lines 32-60, which discloses**

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that the system 20 differentiates element 22 and 24 from each other and that the host device can comprises a set-top box, a personal video recorder or other source of audiovisual information, this differentiation is made by determining a characteristic of both of the elements 22 and 24], and the buffering capacity of the second portion is responsive to at least one characteristic of a second I/O device that provides data to the memory device interface via the second data transfer link [see column 7, lines 5-19, 37-43, 59-62 and column 4, lines 32-60, which discloses that the system 20 differentiates element 22 and 24 from each other and that the host device can comprises a set-top box, a personal video recorder or other source of audiovisual information, this differentiation is made by determining a characteristic of both of the elements 22 and 24.]

(Emphasis added.) As can be readily verified, the rejection of claim 6 is now SIGNIFICANTLY different than the rejection of that claim set out in the previous Office Action. In fact, this is the first time during the prosecution of this application that the Examiner has advanced this argument. As such, Applicants have not had a fair opportunity to consider and respond to this argument (either by argument or amendment). As the present Office Action has been made FINAL, the Applicants' ability to respond to this new argument by amendment (if appropriate) has been unduly restricted.

The FINAL Office Action has similarly advanced new substantive grounds for rejections with respect to independent claims 10, 15, and 19, which new grounds were not necessitated by any prior amendments made by Applicants.

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CONCLUSION

In short, the status of the prosecution of this application has been made FINAL prematurely, and the FINALITY of the latest Office Action should be withdrawn so that Applicants are given a fair opportunity to properly develop the record for Appeal.

Respectfully submitted,



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